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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,297	04/12/2001	Jeffrey A. Bluestone	GNN-014CP	4765

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EXAMINER

ROARK, JESSICA H

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 08/19/2003

Remanded
3/4/04

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,297

Applicant(s)

BLUESTONE ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1644

DETAILED ACTION

1. Applicant's amendment, filed 11/19/02 is acknowledged.
Claims 1-33 are pending.

Sequence Compliance

2. The instant application appears to be in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

Drawing Requirement

3. The formal drawings submitted 2/13/2002 have been approved by the Draftsman.

Restriction Requirement

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-15, drawn to a construct for downmodulating an immune response comprising a portion of an antibody to CTLA4 and an MHC molecule, classified in Class 530, subclass 810.
 - II. Claims 16-17 and 22-26, drawn to a method of downmodulating an immune response by administering a construct comprising a portion of an antibody to CTLA4 and an MHC molecule, classified, e.g., in Class 514, subclass 885.
 - III. Claims 18-23, 25-31, drawn to a method of downmodulating an immune response comprising causing a cell of the subject to express a portion of an antibody to CTLA4, classified in Class 424, subclass 93.21.
 - IV. Claim 32 and 33, drawn to a method of preparing and transplanting an allogeneic cell wherein the allogeneic cell is caused to express a portion of an antibody to CTLA4, classified in Class 435, subclass 334.

The Inventions are distinct, each from the other because:

5. Groups I and II are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of Group II can be practiced with an antibody to CD3 or other immunosuppressants such as prednisone.
6. Groups II, III and IV are different methods. Each method differs with respect to one or more of ingredients, method steps, or endpoints; therefore, each method is patentably distinct.

Art Unit: 1644

7. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Moreover, a prior art search also requires a literature search, which would not be completely co-extensive. It is an undue burden for the examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

Species Election

8. This application contains claims directed to the following patentably distinct species of the claimed Inventions I and II: wherein the MHC molecule is:

- A) syngeneic class II,
- B) syngeneic class I, or
- C) allogeneic class I.

These species are distinct because the structure of each molecule differs; thus each construct comprising represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

9. This application contains claims directed to the following patentably distinct species of the claimed Inventions I and II: wherein the exposed surface is:

- A) an acellular lipid bilayer,
- B) a cellular bilayer that is non-eukaryotic,
- C) a cellular bilayer that is a eukaryotic cell syngeneic to the subject, or
- D) a cellular bilayer that is a eukaryotic cell allogeneic to the subject.

These species are distinct because the structure and source of the exposed surface differs; thus each construct comprising represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Art Unit: 1644

10. This application contains claims directed to the following patentably distinct species of the claimed Inventions I and II: wherein the antibody is attached to the exposed surface by:

- A) a phosphatidylinositol-glycan anchor,
- B) a transmembrane domain, or
- C) a chemical linkage.

These species are distinct because the structure that results from each linkage differs; thus each construct comprising represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

11. This application contains claims directed to the following patentably distinct species of the claimed Invention II and III: wherein the immune response is:

- A) against a non-self antigen, or
- B) against a self antigen.

These species are distinct because patient populations and nature of the immune response differs; thus each method represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16, 17 and 18 are generic.

12. This application contains claims directed to the following patentably distinct species of the claimed Invention III: wherein the cell of the method further expresses:

- A) no MHC molecule,
- B) an MHC class I molecule, or
- C) an MHC class II molecule.

These species are distinct because the effect on the immune response differs depending upon the molecules expressed by the cell; thus each method represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 18 is generic.

Art Unit: 1644

13. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

14. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
August 15, 2003

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8/18/03